

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Lilian Alcaraz et al. Art Unit : 1625
Patent No. : 7,956,070 Examiner : Celia Chang
Issue Date : June 7, 2011 Conf. No. : 2655
Serial No. : 10/587,633
Filed : July 28, 2006
Title : NOVEL PIPERIDINES AS CHEMOKINE MODULATORS (CCR)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 1,166 days to 1,207 days is respectfully requested.

REMARKS

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before September 28, 2007 (the date that is fourteen months after July 28, 2006, the date on which the application was filed). The PTO mailed the first non-final Office Action on July 9, 2009, thereby according a PTO Delay of 650 days. Patentees do not dispute the PTO’s calculation for this “A Delay” from September 29, 2007 (the day after the date that is fourteen months after the date on which the application was filed), to July 9, 2009. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

A PTO action was due on or before December 10, 2009 (the date that is four months after August 10, 2009, the date on which a response to Office Action was filed). The PTO mailed a non-final Office Action on December 17, 2009, thereby according a PTO Delay of 7 days.

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: August 8, 2011.

Applicant : Lilian Alcaraz et al.
Patent No. : 7,956,070
Issued : June 7, 2011
Serial No. : 10/587,633
Filed : July 28, 2006
Page : 2 of 4

Attorney's Docket No.: 06275-0518US1 / 101318-1P US/R&I

Patentees do not dispute the PTO's calculation for this "A Delay" from December 11, 2009 (the day after the date that is four months after the date on which a response to Office Action was filed), to December 17, 2009. See 37 C.F.R. §§ 1.702(a)(2) and 1.703(a)(2).

In view of the periods of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as 657 days (i.e., the sum of 650 days and 7 days).

"B Delay"

The period beginning on July 29, 2009 (the day after the date that is three years after July 28, 2006, the date on which the application was filed), and ending June 7, 2011 (the date the patent was issued), is 679 days in length.

"B Delay" may not include the number of days in the period beginning on the date on which a Request for Continued Examination was filed and ending on the date the patent was issued. In the present application, no Request for Continued Examination was filed.

See 37 C.F.R. §§ 1.702(b)(1) and 1.703(b)(1).

In addition, "B Delay" may not include the number of days in the period beginning on the date on which a Notice of Appeal was filed and ending on the date of mailing of either an action under 35 U.S.C. § 132 or a Notice of Allowance. In the present application, no Notice of Appeal was filed. See 37 C.F.R. §§ 1.702(b)(4) and 1.703(b)(4).

In view of the periods of "B Delay" detailed above, the total "B Delay" for this patent should be calculated as 679 days. The PTO calculated 679 days of delay for issuance of a patent more than three years after filing. Patentees do not dispute the PTO's calculation for this "B Delay" is 679 days. See 37 C.F.R. §§ 1.702(b) and 1.703(b).

Overlap of "A Delay" and "B Delay"

As detailed above, 657 days of "A Delay" accumulated during the following periods:

September 29, 2007, to July 9, 2009; and

December 11, 2009, to December 17, 2009.

As detailed above, 679 days of “B Delay” accumulated during the following period:

July 29, 2009, to June 7, 2011.

As such, the periods of “A Delay” and “B Delay” overlap (i.e., occur on the same calendar day) for a total of 7 days, from December 11, 2009, to December 17, 2009.

Applicant Delay

A reply to an Office Action was due on or before March 17, 2010 (the date that is three months after December 17, 2009, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on June 17, 2010, thereby according an Applicant Delay of 92 days. Patentees do not dispute the PTO’s calculation for this Applicant Delay from March 18, 2010 (the day after the date that is three months after the date on which the Office Action was mailed), to June 17, 2010. See 37 C.F.R. § 1.704(b).

Patentees filed an Amendment Pursuant to 37 C.F.R. § 1.312 on March 29, 2011, subsequent to the mailing of the Notice of Allowance. The PTO mailed a response to the Amendment Pursuant to 37 C.F.R. § 1.312 on April 27, 2011. An Applicant Delay of 71 days was assessed for this post-allowance filing, as it was improperly coded in the PAIR system as an “Information Disclosure Statement.” Patentees respectfully submit that the mailing of the response to the Amendment Pursuant to 37 C.F.R. § 1.312 on April 27, 2011, ends the period of delay, as intended in 37 C.F.R. § 1.704(c)(10), and asks that the Office recalculate the Applicant Delay as 30 days. *Id.*

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 122 days (i.e., the sum of 92 days and 30 days).

Terminal Disclaimer

This patent is subject to a terminal disclaimer. In it, Patentees waive and disclaim the terminal portion of the term of the entire patent to be granted upon the present patent subsequent to the expiration dates of U.S. Patent No. 7,709,500, provided that any patent granted on the present application shall be enforceable only for and during such period that it is commonly owned with U.S. Patent No. 7,709,500.

Applicant : Lilian Alcaraz et al.
Patent No. : 7,956,070
Issued : June 7, 2011
Serial No. : 10/587,633
Filed : July 28, 2006
Page : 4 of 4

Attorney's Docket No.: 06275-0518US1 / 101318-1P US/R&I

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 1,166 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,329 days (i.e., the sum of 657 days of "A Delay" and 679 days of "B Delay" minus 7 days overlapping delay);
- 2) Total Applicant Delay should be calculated as 122 days; and
- 3) Total PTA should be calculated as 1,207 days.

The fee of \$200 required under 37 C.F.R. § 1.18(e) is being submitted herewith. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing attorney docket number 06275-0518US1.

Respectfully submitted,

Date: August 8, 2011

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